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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,993	02/05/2004	Robert Taft	J0227.70001US01	5388

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BOSTON, MA 02210-2206

EXAMINER

PLUCINSKI, JAMISUE A

ART UNIT	PAPER NUMBER
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3629

MAIL DATE	DELIVERY MODE
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03/04/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/772,993	Applicant(s) TAFT ET AL.	
	Examiner JAMISUE A. PLUCINSKI	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-11,16-18 and 27-32 is/are pending in the application.
- 4a) Of the above claim(s) 10,16-18 and 30-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-9,11 and 27-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3 and 27-29 are rejected under 35 U.S.C. 102(b) as being anticipated by The Jackson Laboratory (www.jax.org) in view of Nomura (US 2003/0237104).

3. With respect to Claim 1: The Jackson Laboratory discloses the use of a business which performs a method of providing a plurality of mouse colony management services to customers (See Page 3) comprising:

- a. Receiving an order from a customer that indicates a service desired (see Page 8, Customer Service and Ordering);
- b. Providing the plurality of services to the customer by utilizing a core process and optionally a service-specific process, whereby the core process is shared by a plurality of services (See Related Services, Page 3).

4. The Jackson Laboratory discloses the use of embryos being produced as well as the use of surrogate mothers, however fails to disclose the plurality of services is selected from rapid expansion of a mouse colony and rapid production of synchronized progeny. Nomura discloses the use of superovulating a female mouse, then collecting the eggs, doing IVF, then

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impregnating female mice to produce off spring. It is the examiner's position that superovulating a mouse, would cause rapid production, due to the fact that the specification discloses this as producing the rapid production, as well as the fact that if superovulated the female mouse would produce an egg faster, which would be rapid (See Figure 4 with detailed description as well as Paragraphs 0113-0117). It would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify The Jackson Laboratory, to have the embryos which are implanted into mice to produce off spring, be produced by superovulating the female and IVF, as disclosed by Nomura, in order to increase Quality Assurance for the offspring (See Nomura, Pages 4 and 5)

5. It should be noted that "the length of time needed to produce the desired number of progeny is reduced by more than half" is considered to be the desired outcome of the rapid production service, and is not an actual step in the method.

6. With respect to Claim 3: See Nomura, Figure 4 with corresponding detailed description.

7. With respect to Claim 21: See The Jackson Laboratory Page 3.

8. With respect to Claims 5-7 and 22-24: See The Jackson Laboratory Page 4.

9. With respect to Claim 8: The Jackson Laboratory discloses (page 13) that the laboratory operates a frozen mouse embryo repository which preserves important stocks and strains of mice and upon request the strains can be thawed and carried to full term by foster mothers. The claims are directed to ordering and providing services, not a new in-vitro fertilization method, there are no positive steps of actually doing the process, but are drawn to providing a service, which is the process. Therefore whether the embryo was harvested at a 2-cell stage or a different stage does not effect the actual claimed steps; the actual steps of receiving an order and

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providing services are performed the same regardless of what stage the embryo is harvested.

Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F .2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F .3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

10. With respect to Claims 9 and 26: See The Jackson Laboratory Page 6.

11. With respect to 11: See Nomura Figure 4 with detailed description, and The Jackson Laboratory, Pages, 4 and 13.

12. With respect to Claim 27: The Jackson Laboratory discloses the use of a system for providing a plurality of mouse services comprising a customer module (Page 8), a surgery and implantation module as well as a cryo-preservation module (See Pages 3 and 4). Nomura discloses an IVF module (See Figure 4) With respect to the limitation "wherein the plurality of mouse management services are provided to customers by utilizing a combination of at least three of these modules" is considered to be intended use of the system. Furthermore, the system only requires three of the modules, therefore how can four then be utilized?

13. With respect to Claim 28: The Jackson Laboratory offers information which is all found on a website and discloses the use of education. Therefore the examiner considers the system to be computer implemented.

14. With respect to Claim 29: This claim is rejected as being directed to an unselected species of the Markush group in Claim 27, The Jackson Laboratory and Nomura meet the claim limitation without providing the live animal module, therefore The Jackson Laboratory and Nomura combined, anticipate Claim 29 as well.

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Response to Arguments

15. Applicant's arguments with respect to claims 1, 3, 5-9, 11 and 27-29 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMISUE A. PLUCINSKI whose telephone number is (571)272-6811. The examiner can normally be reached on M-Th (5:30 - 4:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jamisue A. Plucinski/
Primary Examiner, Art Unit 3629